Application No. 10/693,163
July 11, 2005
Amendment responsive to Office Action of May 12, 2005

Remarks

All pending Claims 1 – 20 stand rejected by the Examiner under 35 U.S.C. §102(e). The reference relied upon by Examiner to reject the claims is U.S. 6,804,684 B2 issued to *Stubler et al.*

In response to the Office action, Applicant has amended the specification. Applicant stand by the assertion that the claimed invention is different from that of *Stubler et al* but that Examiner does not yet appreciate the distinguishing characteristics. The amendment to the specification is intended to convey to those skilled in the art, including Examiner, exactly what distinguishes the claimed embodiments from the invention of *Stubler et al.*

Requirements for *Prima Facie* Anticipation

A general definition of *prima facie* unpatentability is provided at 37 C.F.R. §1.56(b)(2)(ii):

> A *prima facie* case of unpatentability is established when the information *compels a conclusion* that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability. (*emphasis added*)

"Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W.L. Gore & Associates v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983) (citing *Soundscriber Corp. v. United States*, 360 F.2d 954, 960, 148 USPQ 298, 301 (Ct. Cl.), adopted, 149 USPQ 640 (Ct. Cl. 1966)), *cert. denied*, 469 U.S. 851 (1984). Thus, to anticipate the applicants' claims, *Stubler et al* must disclose each

element recited therein. "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991).

To overcome the anticipation rejection, the applicants need only demonstrate that not all elements of a *prima facie* case of anticipation have been met, *i. e.*, show that *Stubler et al* fails to disclose every element in each of the applicants' claims. "If the examination at the initial state does not produce a prima face case of unpatentability, then without more the applicant is entitled to grant of the patent." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443, 1444 (Fed. Cir. 1992).

Application of Anticipation Requirements

With respect to the rejection of independent claims 1, 10, and 18, the Examiner cites Figs. 5-7 of the *Stubler et al* reference for its teaching of searching a database for similar images, collecting metatags, and gathering statistics.

Applicant teaches a database statistics module that is an enhancement to a standard content-based image retrieval module and that is <u>not</u> part of the database. Database statistics are stored in the database statistics module so that the time consuming task of gathering the statistics is replaced by a simple query into the database statistics module. In essence, it appears that examiner parses the phrase "database statistics module" as "database (statistics module)" whereas applicant teaches "(database statistics) module".

Stubler et al explicitly teaches, particularly in Fig. 5, gathering statistics anew when a new image is presented to the system. *Stubler et al* does not teach a module that keeps and maintains statistics independent of the database. As examiner notes, *Stubler et al* teaches a program module "that performs the analysis of the numerical information in the metadata".

Examiner notes that adding images, metatags, or other data to the database updates the database statistics. This is true. However, adding images or metatags to the database does not update the database statistics module. Something more is required and therein lays the distinguishing feature.

The inherent statistics of data stored in a database are different from the statistics stored and maintained in a database statistics module. For example, the number of marbles in a jar is an inherent statistic. Adding or taking marbles automatically updates the inherent statistic. A person can count the marbles. A smarter person can write the number of marbles on the jar. A casual observer can tell, by looking at the number written on the jar, how many marbles are inside. If a marble is added, however, the written number is not automatically updated. The smarter person must maintain the written number to keep it accurate.

The person counting the marbles corresponds to the program module of *Stubler et al* gathering statistics. The smarter person who writes and maintains the written number corresponds to the database statistics module.

A database statistics module can complicate adding images and metatags to a database because the statistics stored in the database statistics module must be updated to accurately reflect the database statistics that are inherent in the database. The advantage of having the database statistics module is that database statistics are immediately available.

Stubler et al does not teach a content-based image retrieval module that is enhanced by a database statistics module. *Stubler et al* does teach a content-based image retrieval module that pulls images from a database and that the database also holds metatags that are associated with the images.

The foregoing reasons, rejection of the claims should be reconsidered with the certain knowledge that the database statistics module is separate from the database and must be explicitly maintained such that its stored statistics reflect the database's inherent statistics.

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Conclusion

In view of the foregoing remarks, the Applicant submits that Claims 1-20 are patentably distinct over the reference and are in allowable form. Accordingly, the Applicant earnestly solicits the favorable consideration of the application, and respectfully request that it be passed to issue in its present condition.

Should the Examiner discern any remaining impediment to the prompt allowance of the aforementioned claims that might be resolved or overcome with the aid of a telephone conference, he is cordially invited to call the undersigned at the telephone number set out below.

Respectfully submitted,

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